

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TINA MARIE NIELSEN and LARRY M. NIELSEN

Appeal No. 2005-1820
Application No. 09/591,539

ON BRIEF

Before McQUADE, NASE and BAHR, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Tina Marie Nielsen et al. appeal from the final rejection of claims 15-28. Claims 29-48, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

THE INVENTION

The invention relates to "a towel or blanket having an integral carrying case" (specification, page 1). Representative claim 15 reads as follows:

15. A combination of a flexible sheet usable as a towel or blanket and a carrying case integral with said flexible sheet comprising:

a flexible, rectangular sheet having first and second ends and first and second longitudinal edges; and

a flexible carrying case reversible from a transport and storage mode to a use mode by pulling said carrying case inside out, said carrying case having first and second ends and front and rear walls, said carrying case being open at said first end and closed at said second end, said front and rear walls of said carrying case in said transport and storage mode each having an outer surface and an inner surface, a portion of said inner surface of one of said front and rear walls of said carrying case being permanently attached to said sheet at a location inwardly of said first end of said sheet and between said first and second longitudinal edges of said sheet, said carrying case wholly containing said sheet within said carrying case in said transport and storage mode, said sheet being wholly deployed outside of said carrying case in said use mode with said open first end of said carrying case facing one of said longitudinal edges of said sheet and with said outer surface of said carrying case forming the inner surface of a pillow case.

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THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Silvestri	4,273,380	Jun. 16, 1981
Hunt	5,072,467	Dec. 17, 1991
Buhot et al. (Buhot)	5,346,308	Sep. 13, 1994
Terrazas	5,414,881	May 16, 1995
Wade	Des. 359,411	Jun. 20, 1995
Battistella	5,644,807	Jul. 08, 1997

THE REJECTIONS

Claims 15, 18, 19, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wade in view of Hunt.

Claims 16, 17 and 25-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wade in view of Hunt and Silvestri.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wade in view of Hunt, Battistella and Buhot.

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wade in view of Hunt and Terrazas.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wade in view of Hunt and Battistella.

Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wade in view of Hunt, Silvestri and Battistella.

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Claims 15, 18, 20, 21 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt.

Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt in view of Wade.

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt in view of Terrazas.

Attention is directed to the brief filed April 22, 2004 and to the Office action mailed February 28, 2002 and answer mailed July 12, 2004 for the respective positions of the appellants and examiner regarding the merits of these rejections.

DISCUSSION

I. The rejections premised on Wade as the primary reference

The Wade patent discloses and claims "[t]he ornamental design for a combined fitted lounge chair cover, face cloth and tote bag, as shown and described."

The examiner (see page 3 in the answer) concedes that Wade does not meet the limitations in independent claim 15, or the corresponding limitations in independent claim 25, requiring the carrying case to have (1) a portion of the inner surface of one of its front and rear walls permanently attached to the sheet at a location inwardly of the first end of the sheet and between the

first and second longitudinal edges of the sheet, and (2) an open end facing one of the longitudinal edges of the sheet. As best shown in Figures 3 and 6, the carrying case (i.e. tote bag) and sheet (i.e., lounge chair cover) disclosed by Wade appear to be attached along a line defined by facing portions of the open end of the case and the upper end of the sheet. To overcome the admitted deficiencies of Wade, the examiner looks to Hunt.

Hunt discloses a beach towel 10 comprising (1) a rectangular sheet 12 of toweling material having a top edge 14, a bottom edge 16, a left edge 18 and a right edge 20, and (2) an envelope 26 composed of an inner panel 28, an outer panel 30 and a flap 48. The inner and outer panels are stitched to one another and to the sheet 12 along a bottom panel edge 32, left panel edge 34 and right panel edge 36 to form a pocket 44 between the inner panel 28 and the sheet 12. Both the envelope 26 and the underlying pocket 44 open toward the top edge of the sheet 12 and are adapted to hold sand for weighing the towel down against the wind or personal items such as cigarettes and sun burn lotion. Hunt also teaches that the envelope 26 "is sized and positioned so as to serve as a head rest or pillow [and] [i]t is spaced close to the top edge 14 of the towel sheet, and it is wider than it is tall in the general

proportions of a rectangular pillow" (column 2, lines 64 through 67).

In proposing to combine Wade and Hunt to reject claims 15 and 25, the examiner submits that it would have been obvious "to make the case of Wade attach inwardly of the first end of the sheet for the purpose of allowing it to better function as a pillow, should it be used in that manner" (answer, page 4) and further "to rotate the case of Wade 90 degrees and around the edge of the sheet, so that it faced a longitudinal edge of the sheet, for the purpose of allowing the case to be more conveniently used as a storage bag, when someone is lying on the sheet" (answer, page 4).

The appellants' position that this proposed modification of the prior art stems solely from impermissible hindsight is well taken. The tote bag disclosed by Wade and the envelope disclosed by Hunt differ significantly in terms of their construction and the manner in which they are joined to their respective sheets. The combined disclosures of Wade and Hunt would not have provided the artisan with any suggestion or motivation to reposition Wade's tote bag such that a portion of one of its walls is permanently attached to the lounge chair cover at a location inwardly of the first end of the cover and between the first and second longitudinal edges of the cover, let alone to additionally reorient the bag such that its

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open end faces one of the longitudinal edges of the cover. Hence, the examiner's conclusion that Wade and Hunt would have suggested a towel or blanket responsive to the subject limitations in claims 15 and 25 is unsound.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claim 15, and dependent claims 18, 19, 21 and 22, as being unpatentable over Wade in view of Hunt.

Inasmuch as Silvestri, Battistella, Buhot and/or Terrazas do not cure the failings of Wade and Hunt relative to the limitations at issue in independent claims 15 and 25, we also shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 25, and dependent claims 16, 17, 26 and 27, as being unpatentable over Wade in view of Hunt and Silvestri, the standing 35 U.S.C. § 103(a) rejection of dependent claim 20 as being unpatentable over Wade in view of Hunt, Battistella and Buhot, the standing 35 U.S.C.

§ 103(a) rejection of dependent claim 23 as being unpatentable over Wade in view of Hunt and Terrazas, the standing 35 U.S.C. § 103(a) rejection of dependent claim 24 as being unpatentable over Wade in view of Hunt and Battistella, or the standing 35 U.S.C. § 103(a) rejection of dependent claim 28 as being unpatentable over Wade in view of Hunt, Silvestri and Battistella.

II. The rejections premised on Hunt as the primary reference

The examiner (see page 4 in the answer) allows that Hunt does not meet the limitation in independent claim 15 requiring the carrying case to have an open end facing one of the longitudinal edges of the sheet. As indicated above, Hunt's "carrying case" (i.e., envelope 26) opens toward the top edge of the sheet 12. Nonetheless, the examiner concludes that it would have been obvious "to rotate the case 26 of Hunt 90 degrees so that it faced a longitudinal edge of the sheet, so that it might be more conveniently accessed when someone is lying on the sheet" (answer, page 4). Hunt, however, does not provide any factual support for this conclusion. Indeed, Hunt's stated desire to size and position envelope 26 to permit it to function as a rectangular head rest or pillow actually teaches away from rotating it 90 degrees, and hence belies the examiner's conclusion of obviousness.

Consequently, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claim 15, and dependent claims 18, 20, 21 and 24, as being unpatentable over Hunt.

Since neither Wade nor Terrazas accounts for the shortcomings of Hunt relative to parent claim 15, we also shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 16 and 17 as being unpatentable over Hunt in view of Wade, or the standing


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35 U.S.C. § 103(a) rejection of dependent claim 23 as being unpatentable over Hunt in view of Terrazas.

SUMMARY


The decision of the examiner to reject claims 15-28 is reversed.

REVERSED


JOHN P. McQUADE
Administrative Patent Ju


JEFFREY V. NASE
Administrative Patent Judge

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JENNIFER D. BAHR
Administrative Patent Judge

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